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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,208	02/27/2004	Manaw Modi	5793.3119-00	4685
22852	7590	12/09/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
AHMED, AFFAF				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
12/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/787,208

Applicant(s)

MODI, MANAW

Examiner

AFAF AHMED

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-30 and 32-40 is/are pending in the application.
4a) Of the above claim(s) 12 and 31 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 and 13-30 and 32-40 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17 (e), was filed in this application after final rejection. since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17 (e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/02/2008 has been entered.
2. Claims 1, 13, 15, 21, 32 and 38 have been amended.
3. Claims 12, 31 have been canceled.
4. Claim 40 has been added.
5. Claims 1-11, 13-30 and 32-40 are currently pending and have been examined.

Response to Applicant's Arguments

6. With respect to claim 1, Arguments are moot based on the new ground of rejection (s).
7. With regard to claims 36 and 37 Applicant argues that Todd does not disclose or suggest an incentive report that includes information associated with incentives that may have been applied to consumer account. Todd in at least paragraph 45 discloses a system that is configured to reward users by adding value to each account each time the user performs a transaction and in at least paragraph 46 Todd discloses presenting consumers with monthly statements of the consumers' activities of an account. Todd also in paragraph 48 discloses accumulating transaction information used in periodically billing users of the services and accumulated rewards value on behalf of each consumer based on transactions completed by that customer using the financial services. Furthermore, Todd in at least paragraph 73 discloses the reward generator from an associated reward record provides a total reward value accumulated during the current billing cycle or other predetermined time.
8. With regard to claim 19, Applicant argues the at Todd does not disclose, *ranking the transaction based on a transaction parameter associated with each transaction; identifying a set of transactions each have a transaction parameter that meets or exceeds a predetermined transaction parameter threshold and determining whether the set of transactions meet the at least one predetermined condition.* Todd in at least paragraph 25 discloses for each reward value generated a number is assigned based in part of the monetary amount of the associated transaction. The number is determined based on the location of the transaction, the timing of the transaction and an accumulated reward value in the associated reward record. The award value may rise from a credit balance or aggregating amount of purchases exceeding a threshold for a given time period. Thus a transition and/ or a set of transactions can be identified whether the transaction meet or exceeds a certain condition.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claim 21 is rejected under 35 U.S.C. 101 because the limitations recite a system per se which may be equated to that of interconnected devices which is defined by its physical structural elements and corresponding functionality. No physical structural elements are recited in the claim. The claim is directed to non statutory subject matter. The body of the claim comprises Living Subject Matter, which is not physical structures element of the system (MPEP§ 2105).

11. Claims 39 and 40 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

12. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 39 and 40 are non-statutory since they may be preformed within the human mind.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claim 21 recites a system for providing incentives for a first financial account. A system claim must cite structure of the system, which Applicant has not cited. Appropriate correction and/or clarification is required.

16. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the

individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claims 1-11, 13-31 and 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub No: 2003/0061093 A1 in view of Walker et al, US Pat No: 5,949,044.

Claims 1, 21, 38 and 39:

Todd discloses:

- *monitoring transactions performed using the first and second financial accounts over a predetermined transaction monitoring period; determining whether the monitored transactions meet at least one predetermined condition; and applying an incentive to the first financial account based on the predetermined condition (see at least paragraphs 45 and 73);*
- *applying an incentive to the first financial account based on the predetermined condition (see at least paragraphs 24-25);*
- *determining the computer system whether any transactions that meet the predetermined condition are associated with the second financial account (see at least paragraph 69);*

Todd does not specifically disclose, but Walker, however, discloses:

- transferring transaction amount between credit cards accounts (see at least column 9, lines 38-62);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Todd's system for rewarding customers of financial services providers with Walker's method and system for credit line transfers with the motivation of increasing revenue to the primary financial institution and encouraging or rewarding a specific customer behavior with respect to a specific financial account.

Claims 2 and 22:

Todd/ Walker disclose the limitations as shown above.

Todd further discloses:

- *collecting, by the first financial account provider, transaction information associated with each of the transactions from at least one of: the user, a merchant associated with a transaction with the user, a server system that collects the transaction information, and the second financial account provider* (see at least paragraph 48);

Claim 3:

Todd/ Walker disclose the limitations as shown above.

Todd further discloses:

- *configuring the first financial account based on input received from the user* (see at least paragraph 31);

Claims 7, 9, 20, 26 and 28:

Todd/ Walker disclose the limitations as shown above.

Todd discloses:

- *monitoring transactions information for each account* (see at least paragraphs 17 and 19 and paragraph 62);

Claims 8,10,11,18, 19, 27, 29, 30 and 37:

Todd/ Walker disclose the limitations as shown above.

Todd further discloses

- *applying variety of incentives based on different category of transactions* (see at least paragraphs 25 - 27);

Claims 13 and 32:

Todd/ Walker disclose the limitations as shown above.

Todd does not specifically disclose, but Walker however discloses:

- *providing a payment for the second financial account transactions from the first financial account provider to the second financial account provider; and adding a total transaction amount associated with the second financial account transactions to a balance associated with the first financial account (see at least abstract;*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Todd's system for rewarding customers of financial services providers with Walker's method and system for credit cline transfers with the motivation of increasing revenue to the primary financial institution and encouraging or rewarding a specific customer behavior with respect to a specific financial account;

Claims 15 and 34:

Todd/ Walker disclose the limitations as shown above.

Todd discloses:

- *wherein the incentive includes at least one of adjusting an interest rate for the first financial account, adjusting a credit limit for the first financial account, adjusting an account fee associated with the first financial account, and adding reward points to accumulating reward point total associated with the first financial account (see at least paragraphs 74-79);*

Claims 16 and 35:

Todd/ Walker disclose the limitations as shown above.

Todd further discloses:

- *wherein the incentive is more attractive to the user when more of the transactions are associated with the first financial account as opposed to the second financial account (see at least paragraphs 3 and 12);*

Claims 17, 18, 36 and 37:

Todd/ Walker disclose the limitations as shown above.

Todd further discloses:

- *providing an incentive report to the user based on the applied incentive;*

- *wherein the incentive report includes information associated with incentives that may have been applied to the first financial account based on different types of the predetermined ;*

See at least paragraphs 45-46, 48, 53 and 73;

Claim 19:

Todd/ Walker disclose the limitations as shown above.

Todd further discloses:

- *ranking the transaction based on a transaction parameter associated with each transaction; identifying a set of transactions each have a transaction parameter that meets or exceeds a predetermined transaction parameter threshold and determining whether the set of transactions meet the at least one predetermined condition (see at least paragraph 25);*

20. Claims 4, 5, 6, 23, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub No: 2003/0061093 A1 in view of Walker et al, US Pat No: 5,949,044 in view of Johnson et al, US Pub No: 2005/0021457 A1.

Claims 4, 5, 6, 23, 24 and 25:

Todd/ Walker disclose the limitations as shown above.

The combination of Todd/ Walker does not specifically disclose, but Johnson however discloses:

- *receiving a forecast goal and determining if the forecast goal is met and applying an incentive to the first account when the forecast goal is met (see at least see the abstract and paragraph 10);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Todd's/ Walker's transferring transactions and rewarding customers of financial services providers with Johnson's system and method of financial account up-front incentives management with the motivation of tracking incentives that will encourage or reward a specific customer behavior with respect to a specific financial account.

21. Claims 14 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub No: 2003/0061093 A1 in view of Walker et al, US Pat No: 5,949,044 in view of Watson, US pat No: 5,991,750.

Claims 14 and 33:

Todd/ Walker disclose the limitations as shown above.

Todd does not specifically disclose, but Watson however discloses:

- *wherein the user gives authorization to transfer transactions* (see at least column 3, lines 32 -54);

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to combine Todd's / Walker's system for rewarding customers and transferring financial accounts between financial services providers with Watson's system and method of pre-authorization of individual account transaction with the motivation of minimizing fraud and abuse in the purchasing of goods and services.

22. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over of Johnson et al, US Pub No: 2005/0021457 A1 in view of Todd, US Pub No: 2003/0061093.

Claim 40:

Johnson discloses:

- *receiving a forecast goal from the user reflecting an estimated transaction amount the user intends to perform using the first financial account over a future transaction monitoring period;*
- *determining whether the transactions includes purchase amounts associated with the first financial account that collectively meet the forecast goal; applying an incentive to the first financial account when the forecast goal is met; and*

See at least the abstract, paragraphs 10-12;

Johnson does not specifically disclose, but Todd however discloses:

- *providing an incentive report to the user based on the applied incentive, wherein the incentive report includes information associated with incentives that may have been applied to the first financial account based on different types of the predetermined condition* (see at least paragraphs 45-46, 48, 53 and 73);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Johnson's system and method of financial account up-front incentives management with Todd's system and method for rewarding customers of financial services providers with the motivation of tracking incentives that will encourage or reward a specific customer behavior with respect to a specific financial account.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

/Yehdega Retta/
Primary Examiner, Art Unit 3622